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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,364	04/12/2001	Tadamasa Kitsukawa	080398.P159C	6493

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Gordon R. Lindeen III
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026

EXAMINER

TRAN, HAI V

ART UNIT PAPER NUMBER

2623

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,364

Applicant(s)

KITSUKAWA ET AL.

Examiner

Hai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/10/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 01/10/2006 have been fully considered but they are not persuasive.

Applicant argues, "The halo around an option is not equivalent to an advertising mark, as claimed, because the halo merely indicates the user's options on the screen and does not have any association with advertising."

In response, the Examiner respectfully disagrees with Applicant because the Halo around an option is an "hot spot", an "advertisement mark" to indicate to user that additional information, i.e., advertisements, infomercials, about the product associated with the "hot spot" is available to user if the user selects on the it by selecting that "hot spot" (see Col. 13, lines 50-62 and Col. 15, line 62-67).

Applicant further argues, "The selection of the Halo around an option does not lead to the display of the received adverting information on the display, as claimed."

In response, the Examiner respectfully disagrees with Applicant because the user by selecting the "hot spot", the system displays the additional information, as advertisement, about the product associated with the "hot spot" (Col. 13, lines 50-62 and Col. 15, line 62-67).

Applicant argues, "Thus, because Holman's coupon offers are not displayed along with the presentation of the television commercial, Holman does not teach or suggest displaying with the presentation of the television commercial, Holman does not teach or suggest displaying an advertisement mark for the item on a display along with scene of the broadcasted program."

In response, the Examiner respectfully disagrees with Applicant because Wistendahl has met the above feature argued by Applicant! Moreover, Applicant's arguments against the references individually, one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In view of the above discussion, the Examiner maintains the rejection.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2,5,6,7,8,9,10 of U.S. Patent No. 6282713. Although the conflicting claims are not identical, they are not patentably distinct from each other because

1. Claims 21, 36 , 45 and 52 corresponds to patent claims 1 and 22 of U.S. Patent No. 6,282,713.

Application claims 21, 36 , 45 and 52 and patent claims 1 and 22 are draw to the same invention. These claims differ in scope in that application claims 21, 36 , 45 and 52 are broader in scope than patent claims 1 and 22.

Allowance of application claims 21, 36 , 45 and 52 would result in an unjustified time-wise extension of the monopoly granted for the invention defined by patent claims 1 and 22. Therefore, obviousness type double patenting is appropriate.

Claims 22, 23, 24, 25, 28, 37, 38, 39, 46, 47, 48, 53, and 54 correspond to patent claim 2.

Claims 26, 27, 40, and 55 correspond patent claim 1.

Claims 29, 41 correspond to patent claims 5 and 10.

Claims 30, 31, 42 and 43 correspond to patent claim 6.

Claim 32 and 49 correspond to patent claim 8.

Claim 33 corresponds to patent claim 19.

Claim 34, 35, 44, 50, 51, 56 and 57 correspond to patent claim 9.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 21-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wistendahl et al. (US 6496981) in view of Holman (US5285278).

Claims 21, 36, 45 and 52, Wistendahl discloses a method, an apparatus, a receiver and a machine-readable medium comprising:

receiving advertising information for an item along with a broadcast of a program (Col. 13, lines 50-62t);

displaying an advertising mark (logo) for the item on a display along with a scene of the broadcasted program (Col. 15, lines 1-7);

displaying the received advertising information on the display upon selection of the advertising mark by a viewer (Col. 9, lines 33-41);

Wistendahl does not disclose storing the displayed advertising information upon selection by a viewer .

Holman discloses storing the displayed advertising information upon selection by a viewer (Col. 5, lines 18-22) for the benefit of later retrieving the

selected information. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wistendahl for storing the selected information, as taught by Holman, so the user able to later retrieve it.

Claims 22, 37 and 46, Holman further disclose storing advertising information for the item for a specified period of time after a corresponding broadcasted program ends (Col.12, lines 21-29).

Claim 23, Holman further discloses storing the displayed advertising information on a smart card (Col. 4, lines 49-54 and Col. 5, lines 51-55).

Claims 24, 38 and 53, Holman further disclose storing information on the smart card regarding an associated broadcast of a program in association with the displayed advertising information (Col. 9, lines 59-64).

Claims 25, 39, 47 and 54, Holman further disclose wherein storing the displayed advertising information on the smart card comprises storing a coupon for the item on the smart card (Col. 5, lines 53-55).

Claims 26, and 55, Holman further disclose printing a coupon upon selection by a viewer and after displaying the received advertising information (Col. 7, lines 30-36).

Claims 27, and 40, Wistendahl further discloses wherein the displayed advertising mark comprises an indicator for a plurality of items for which

advertising information is available, and wherein the indicator is representative of the item to which the indicator corresponds (plurality of hot spots; Col. 13, lines 50-61).

Claims 28, and 48, Holman further discloses storing a coupon for a selected one of the plurality of items on a smart card upon selection by a viewer (Col. 5, lines 18-22).

Claims 29, and 41, Wistendahl (Col. 13, lines 50-54) in view of Holman (Col. 5, lines 8-18) further discloses wherein the displayed advertising mark is superimposed over a broadcast of a program on the display .

Claims 30, and 42, Wistendahl (Col. 13, lines 50-54) further discloses wherein the item is in the displayed scene and wherein the displayed advertising mark comprises an indicator of the item in the displayed scene.

Claims 31, and 43, Wistendahl in view of Holman (Col. 5, lines 33-40) further comprising recalling the stored displayed advertising information and displaying it at a time that is different from a display time of a scene in which an advertised item appears.

Claims 32, and 49, Wistendahl in view of Holman (Fig. 2; el. 40 and 8; Col. 5, lines 8-18) further discloses wherein displaying the advertising information comprises displaying the advertising information on a portion of the display along with the broadcast of a program.

Claim 33, Wistendahl (Col. 13, lines 50-62) in view of Holman further discloses receiving a request from the viewer for electronically ordering the item using the advertising information.

Claims 34, 44, 50 and 56, Wistendahl in view of Holman (Col. 11, lines 60-Col. 12, lines 16) further discloses wherein the advertising information comprises a coupon that is redeemable upon satisfaction of a condition precedent, the method further comprising storing a coupon portion of the displayed advertising information on a smart card only upon satisfaction of the condition precedent.

Claims 35, 51, and 57, Wistendahl in view of Holman (Col. 12, lines 25-60) further discloses comprises a coupon that is redeemable upon satisfaction of a condition precedent, the method further comprising reading a coupon portion of the displayed advertising information on a smart card only upon satisfaction of the condition precedent.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT:ht
03/16/2006



HAI TRAN
PRIMARY EXAMINER